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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,853	03/07/2000	Michael O'Doherty	584-1022	8975

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EXAMINER

FLYNN, KIMBERLY D

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/520,853

Applicant(s)

O'DOHERTY, MICHAEL

Examiner

Kimberly D. Flynn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Detailed Action

1. This action is in response to an Amendment filed December 23, 2004. Claims 1-33 are pending in this application.

Claim Rejections – 35 U.S.C. 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5, 9, 10-15, and 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handley et al. (RFC 2543 – SIP: Session Initiation Protocol) in view of Venkatraman et al. (6,014,688).

In considering claim 1 and 2, Hadley discloses the SIP: Session Initiation Protocol Which is an application-layer control (signaling) protocol for creating, modifying and terminating sessions with one or more participants. These sessions include Internet multimedia conferences, Internet telephone calls and multimedia distribution. Members in a session can communicate via multicast or via a mesh of unicast relations, or a combination of these. Venkatraman discloses an e-mail program capable of transmitting, opening and presenting a container having digital content using embedded executable software the system comprising:

storing the computer software in a message (col. 3, lines 66-67 through col. 4, lines 1-7), and sending the message and computer software code from the first client

associated with the first node to the second client associated with the second node and executing the computer software using the second node (col. 4, lines 7-12).

Email is a message transmitted using the POP/SMTP protocol. The email protocol is limited in functionality(i.e. can not do multimedia, page layout, or receipt confirmation, etc). Venkatraman teaches to improve the email protocol by embedding executable code to perform enhanced functions. It would have been obvious to a person having ordinary skill in the art to modify the SIP: Session Initiation Protocol taught by Hadley to include the embedded software code taught by Venkatraman in order to enable the implementation of enhanced services not provided for by the native SIP protocol. Therefore, the modification would have been obvious.

In considering claims 20 and 26, Venkatraman discloses a communications network node, as well as a communications network comprising a plurality of communications network nodes (see Fig. 1, and col. 3, lines 38-44), with each node comprising:

- a client (Fig. 1, (20);
- an input arranged to receive messages (Fig. 1, (30)); and
- a processor arranged to extract and execute computer software code from a received SIP message (see Fig. 1, (32) and col. 3, lines 50-51).

In considering claims 24 and 25, Venkatraman discloses a computer program, stored on a computer readable medium, arrange to control a communications network node, the node comprising a client(30) and a processor(32c), the computer program being arranged to control the node when executed on the processor such that when a message is received by the client, which contains computer software code, the software code is executed by the processor (See Fig 1, col. 3, lines 50-55 and col. 4, lines 13-20).

Additionally, Handley et al. discloses an SIP client (see page 9, lines 17-19; page 11, lines 4-7), and an input arranged to receive SIP messages received by the SIP server (see page 25, lines 21-33); as well as the execution of software code within an SIP message when that message are received by SIP client (see page 20, lines 18-23).

In considering claims 2 and 10, Venkatraman further discloses a method wherein the computer software code is added to the message (see Venkatraman col. 4, lines 3-7).

In considering claim 5-6, Venkatraman discloses a method wherein the computer software code comprises Java byte code and one or more Java Applets (see col. 7, lines 6-16).

In considering claims 9 and 21, Venkatraman discloses a method wherein the second node comprises a Java virtual machine (see Venkatraman col. 7, lines 6-16).

In considering claims 11 and 23, Handley et al. discloses a method which further comprises adding an indicator to the header of the SDIP message in order to indicate the presence of the computer software code and arranging the second SIP client to recognize the indicator (content-type) (see page 85, lines 4-9).

In considering claim 12, Handley discloses a method which further comprises the step of proceeding with any SIP process related to the SIP message (via general header) (see page 25, lines 22-40; page 26, lines 1-11; page 27, Table 3).

In considering claim 13, although Venkatraman and Handley show substantial features of the claimed invention, they fail to a to specifically disclose a method wherein the second SIP client is arranged such that on receipt of a SIP message containing such an indicator, the computer software code stored in the SIP message is executed by the second node before that second node carries out any other process related to the SIP message. Nonetheless, this

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execution of the computer software would have been an obvious modification to the SIP message containing an indicator for the message body/computer software in its header. It would have been obvious for a person having ordinary skills in the art to modify Venkatraman et al. and Handley et al. by employing a method wherein the second SIP client is arranged such that on receipt of a SIP message containing such an indicator, the computer software code associated with the SIP message is executed by the second node before that second node carries out any other process related to the SIP message in order to provide a level of priority for the message body/computer software over other SIP-specified processes, thus providing for the quick receipt of urgent computer software.

4. Claims 14, 15, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman et al. and Handley et al. as applied to claim 1, and in further view of Gampper et al. (6,003,082).

In considering claims 14, 15, and 22, although the combined system of Venkatraman and Handley show substantial features of the claimed invention, they fail to disclose a method wherein the computer software being arranged to interact with the second SIP client via a specified API. However, Byttner et al. et al., whose invention is a proposal for a Java extension API for SIP servers, discloses such a specified API (see page 3, lines 15-20, lines 35-46). Therefore, given the teachings of Byttner et al., it would have been obvious for a person having ordinary skills in the art to modify Venkatraman et al. and Handley et al. by arranging computer software to interact with the second SIP client via a specified API in order to the services needed to transport data across a network.

5. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman and Handley as applied to claim 1, and in further view of Gampper et al. (6,003,082).

In considering claims 3 and 4, although Venkatraman et al. and Handley et al. show substantial features of the claimed invention, they fail to disclose a method wherein the step of associating computer software code with the SIP message comprises adding a URL to the SIP message which indicates where the computer software is stored. However, Gampper et al., whose invention is the use of a server to selectively filter and cache internet access requests from the terminals attached to the server, discloses such a URL, added to a message, that indicates where computer software code is stored (see col. 2, lines 32-43). Therefore, given the teachings of Gampper et al., it would have been obvious for a person having ordinary skills in the art to modify Venkatraman et al. and Handley et al. by adding a URL to the SIP message which indicates where the computer software is stored in order to reduce the byte overhead of the message body containing the computer software code.

6. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman and Handley as applied to claim 1, and in further view of Lavian et al. (6,175,868).

In considering claims 7 and 8, although Venkatraman and Handley show substantial features of the claimed invention, they fail to disclose a method wherein the computer software code comprises one or more Java mobile agents. However, Lavian et al., whose invention is a method and apparatus for automatically configuring a network switch having external network data ports, a processor, and memory, discloses such a computer software code comprising one or more Java mobile agents (see col. 6, lines 31-41). Therefore, given the teachings of Lavian et

al., it would have been obvious for a person having ordinary skills in the art to modify Venkatraman et al. and Handley et al. by providing computer software code that comprises one or more Java mobile agents in order to provide compatibility with various Java-based environments, including mobile/wireless environments.

Response to Arguments

7. Applicant's arguments filed December 23, 2004 have been fully considered but they are not persuasive.

8. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant is arguing that Venkatraman is concerned with providing an enhanced email message, which works by attaching computer software code to the email message itself and that a skilled person reading on Venkatraman would not learn the step of “storing computer software code in a SIP message” because of the very different types of the messages involved. Applicant is reminded that Venkatraman alone does not teach the claimed limitations, but that Venkatraman in view of Handley teaches the claimed limitations.

While the system disclosed by Venkatraman shows substantial features of the claimed invention, it fails to specifically disclose the clients being SIP clients and the messages being of the SIP protocol. However, Handley whose invention is the Internet standard for SIP, Session Initiation Protocol, discloses such nodes comprising an SIP client (see page 9, lines 17-19; page 11, lines 4-7), as well as an SIP message being sent from the client to the server, with

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the message associated with an option message body (see page 25, lines 21-33). Therefore, given the teachings of Handley it would have been obvious for a person having ordinary skills in the art to modify Venkatraman to utilize the SIP protocol in order to extend the system features for use of various communications protocols such as SIP as well as utilizing software in conjunction with the initialization of multimedia sessions between the client and the server.

Applicant further argues that Handley does not disclose the option of carrying computer software code in a SIP message body. Again the applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references and that Venkatraman alone does not teach the claimed limitations, but that Venkatraman in view of Handley teaches the claimed limitations

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Flynn whose telephone number is 571-272-3954.

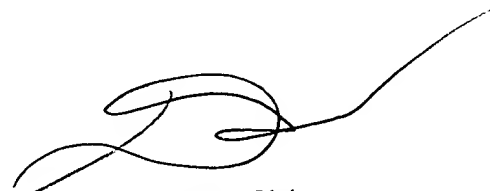
The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly D Flynn
Examiner
Art Unit 2153

KDF

A handwritten signature in black ink, appearing to read 'David C. Flynn', with a long, sweeping horizontal line extending to the right.

David C. Flynn
Primary Examiner